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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,964	11/27/2000	Kaoru Uchida	14098	5139
23389	7590	12/23/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			CARTER, AARON W	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,964

Applicant(s)

UCHIDA, KAORU

Examiner

Aaron W Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5 and 12-14 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2004 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6, 7, 9, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,195,477 to Ross in view of USPN 6,141,436 to Srey et al. ("Srey") and further in view of USPN 5,815,252 to Price-Frances.

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As to claim 1, Ross discloses a user authentication apparatus for authenticating a user by verification of biometrics which are presented by the user and are a biological characteristic unique to the individual user (Fig. 4), comprising:

Acquisition means operable when the authentication by the verification of the biometrics results in failure, for acquiring an additional image of the same biometric of the user for generating biometrics data of the user who has requested the authentication using a sensor and converting the acquired biometrics data into digital data (Fig. 4, elements 56, 58 and 68, wherein when "no" the finger is rescanned).

Ross does not disclose expressly that the acquired biometrics data are stored upon failure of verification or that a substitute authentication means for substituting the verification of biometrics when the biometrics data is acquired by said acquisition means and performing substitute authentication based on data other than the data acquired by said acquisition means.

Srey discloses storing biometric data when verification results in failure (column 9, lines 21-38).

Price-Francis discloses substitute authentication means for substituting the verification of biometrics when the biometrics data is acquired by said acquisition means and performing substitute authentication based on data other than the data acquired by said acquisition means (Fig. 2, wherein the acquisition of fingerprint, at element 66, is compared with stored data, at element 82, and if verification fails, element 110, then the process starts over with acquiring more biometrics and evaluating the substitute biometrics, element 64).

Ross, Srey & Price-Francis are combinable because they are from biometric authentication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to adding the storage of biometric data upon failure, taught by Srey and performing substitute authentication as taught by Price-Francis, to the user authentication apparatus disclosed by Ross.

The suggestion/motivation for doing so would have been that doing so would provide a higher level of security (Srey, column 9, lines 21-23) and enhancing accuracy (Price-Francis, column 2, lines 42-44).

Therefore, it would have been obvious to combine Ross with Srey and Price-Francis to obtain the invention as specified in claim 1

As to claims 6 and 15, the combination of Price-Francis and Srey discloses a user authentication apparatus as claimed in claims 1 and 9, Price-Francis further discloses wherein at least a fingerprint is used as the biometrics (Fig. 2).

As to claim 7, the combination of Price-Francis and Srey discloses a user authentication apparatus as claimed in claim 1, Srey further discloses wherein, upon the storage of the biometrics data acquired using said sensor, at least an image of an inputting process of a fingerprint is photographed and stored (column 9, lines 21-38).

As to claim 9, please refer to the rejections made for claim 1 above.

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As to claim 10, the combination of Price-Francis and Srey discloses a user authentication method as claimed in claim 9, Srey further discloses a step of storing the biometrics data acquired by the step of acquiring the biometrics data, and search and pursuit of an illegal user are performed based on the stored biometrics data (column 9, lines 21-38).

5. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, Price-Francis and Srey as applied to claims 1 and 9 above, and further in view of US Patent 5,799,098 to Ort et al. ("Ort").

As to claims 2 and 11, the combination of Ross, Price-Francis and Srey discloses a authentication apparatus of claim 1 and Price-Francis also discloses that false negatives may be the result of poor quality fingerprint images, therefore immediate rejection of the individual may be premature (column 6, lines 59-67)..

The combination of Ross, Price-Francis and Srey neglects to explicitly disclose the limitation of determining quality of biometric data and if the quality is not suitable for automatic comparison, then the data is to be stored.

Ort teaches us a process of fingerprint identification and authorization in which a fingerprint image acquired, divided into a plurality of blocks each containing biometric data and the quality of each block is determined. Although the quality is determined to be of low quality or unsuitable for automatic comparison, the biometric data is still recorded (Abstract, lines 5-7).

Ross, Price-Francis, Srey & Ort are combinable because they are from same field of biometric authentication.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the combination of Ross, Price-Francis and Srey with the teachings of Ort.

The suggestion/motivation for doing so would have been that this provides rapid comparison of a fingerprint with those fingerprints of individuals in the repository database (column 6, lines 1-3).

Therefore, it would have been obvious to combine Ross, Price-Francis and Srey with Ort to obtain the invention as specified in claims 2 and 11.

6. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, Price-Francis and Srey as applied to claims 1 and 9 above, and further in view of US Patent 6,430,306 to Slocum et al. ("Slocum").

As to claims 8 and 16, the combination of Ross, Price-Francis and Srey discloses a user authentication apparatus as claimed in claims 1 and 9, but neglect to explicitly disclose that upon storage of biometrics data prior to the substitute authentication, at least an image of the face and/or a figure, when a fingerprint is inputted, are photographed. However, Slocum teaches us a process of biometric identification where, as part of an effort to deter individuals from gaining false entry, a photograph of the individuals face is taken and stored for use by law enforcement (column 9, lines 37-45 and column 10, lines 22-32). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to take the biometric identification that provides a reduction of false negatives as disclosed by the combination Ross, Price-Francis and Srey and combined it with the biometric identification technique taught by Slocum, this

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providing improved systems and methods for maintaining databases that store image information as part of a data record.

Allowable Subject Matter

7. Claims 3-5 and 12-14 are allowed.

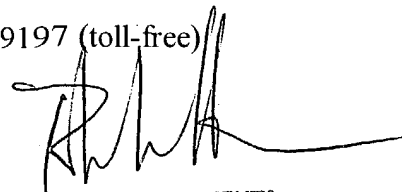
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron W Carter whose telephone number is (703) 306-4060. The examiner can normally be reached on 7am - 3:30 am (Mon. - Fri.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

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